

REMARKS

Claims 1, 3-5, 7-9 and 11-17 are pending and stand ready for further action on the merits. Claim 1 has been amended to more clearly recite that the polyester is formed of dicarboxylic acid as a co-monomer and that the dicarboxylic acid co-monomer is at least one of the acids specifically listed in claim 1.

No new matter has been added by way of the above-amendment.

Issues Under 35 USC § 103

Claims 1, 3, 4, 9 and 11-17 are rejected under 35 USC § 103(a) as being unpatentable over Tachika et al. (US 5,356,989).

Applicants respectfully traverse the rejection.

According to MPEP § 2143.03, a *prima facie* case of obviousness cannot be said to exist if the cited reference(s) fails to teach or fairly suggest each of the limitations in the application claims. Applicants respectfully submit that Tachika et al. fail to teach or fairly suggest each of the elements of the presently claimed invention.

First, Tachika et al. require from 0.01 to 20 mol% (based on the total moles of the polycarboxylic acid component) of a dicarboxylic acid having a metal sulfonate group.

In view of the above amendment, Applicants have clarified that the inventive polyester includes, as the dicarboxylic acid component, only the specific dicarboxylic acids which are listed in

claim 1. Since none of the specific dicarboxylic acids listed in claim 1 have a metal sulfonate group, Tachika et al. fail to teach or fairly suggest this element of the inventive claims.

Second, Applicants respectfully submit that Tachika et al. does not fairly suggest the inventive aqueous dispersion, in view of the fact that the inventive claims require that the aqueous dispersion contains an organic solvent in a concentration of less than 0.5% by mass.

The Examiner has taken the position that Tachika et al. teach that the organic solvent is an optional component "as evidenced by the teaching at col. 2, line 65, $B/(B+C) = 0 - 0.7$." Applicants respectfully submit that Tachika et al. teach away from the use of no organic solvent in such a profound way that the skilled artisan would not find it obvious to not use the organic solvent in the aqueous dispersion of Tachika et al.

Specifically, as can be seen in Table 3, at the bottom of columns 13 and 14, Tachika et al. invariably use between 12 and 21 wt.% of the organic solvent. A reference which leads one of ordinary skill in the art away from the claimed invention cannot render it unpatentably obvious. *Dow Chem. Co. v. American Cyanamid Co.* 816 F2d 617, (CAFC 1987). In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references "must be read as a whole and consideration must be given where the references diverge and teach

away from the claimed invention." *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986); *In re Fine*, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness. *United States v. Adams*, 383, U.S. 39, 52 (1966).

Accordingly, since Tachika et al. teach away from using the organic solvent in a concentration of less than 0.5% by mass, as presently claimed, Tachika et al. fail to fairly suggest this element of the present claims.

In conclusion, Applicants respectfully submit that a *prima facie* case of obviousness cannot be said to exist, since Tachika et al. fail to teach or fairly suggest: (a) the formation of a polyester having as the carboxylic acid component, at least one of the specific carboxylic acids which are recited in inventive claim 1 without the use of a carboxylic acid containing a metal sulfonate group; and (b) the use of an aqueous dispersion which contains an organic solvent in a concentration of less than 0.5% by mass. As such, withdrawal of the rejection is respectfully requested.

Allowable Subject Matter

Applicants note with appreciation that the Examiner has indicated that claims 5, 7 and 8 contain allowable subject matter.

CONCLUSION


In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.** (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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